

REMARKS

The Office Action mailed June 30, 2005 has been received and reviewed. Claims 1-19 and 40-91 are in the case. Claims 1-2, 5-17, and 40-91 stand rejected under 35 U.S.C. §112 ¶1 as failing to comply with the written description requirement. Claims 1, 2, 5-17, and 40-91 stand rejected under 35 U.S.C. §112 ¶2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. Claims 1, 2, 5-9, 13-17, 19, 49, 50, and 72-73 stand rejected under 25 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,837,091 to Theil et al.. Claims 10-12 and 60-62 stand rejected under 25 U.S.C. §103(a) as being unpatentable over Theil alone. Claims 1, 2, 5-9, 13-17, 40-61, and 63-91 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,894,048 to Eckart in view of U.S. Patent No. 4,138,300 to Kaetsu et al.. Claims 10-12 and 60-62 stand rejected under 25 U.S.C. :§103(a) as being unpatentable over Eckart et al. and Kaetsu. Claim 19 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Eckart et al, Kaetsu et al., and Theil et al..

REJECTION UNDER §112

Claims 1-2, 5-17, and 40-91 stand rejected under 35 U.S.C. §112 ¶1 as failing to comply with the written description requirement. In order to satisfy §112 ¶1, the subject matter of a claim must be described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to Claims 1-2, 5-17, and 40-91, Examiner has requested that Applicant point out disclosure in the specification supporting claim scope including a non-flat “non-porous unitary solid surface” and a non-flat “thermoplastic non-copolyester polymeric material.”

The specification, as originally filed in the present case, included multiple indications that the solid-surface structure is formed into non-flat structures in some applications. The

specification discloses that “[t]he inventive solid surface products may be employed to make countertops, sinks, lavatories, desktops, table tops, chairs, windowsill, and the like.” p. 6, lns. 1,2. Claims 41 and 42 as originally filed also refer to lavatories and sinks formed using the inventive laminate disclosed by Applicant. Claims filed with a patent application may be used to show possession of the invention under § 112 ¶1. MPEP 2163 (“It is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification”). The above-cited passages from the original specification in combination with the knowledge of one skilled in the art show that Applicant had possession of the invention at the time of filing.

With respect to the term “decorative object” recited in claim 1, the specification recites that the non-porous polymeric sheets 16 and 18 which envelop the decorative object may be “frosted, translucent, [and] opaque.” p. 8, ln. 4. Any of these attributes is sufficient to render a decorative object captured between the polymeric sheets 16 and 18 non-visible. Opaque, for example, is defined as “blocking the passage of radiant energy and especially light.” Merriam Webster Dictionary.

With respect to Claims 10-12, Applicant asserts that the specification discloses a five layer laminate. The specification states that:

the basic lay-up sandwich may consist of: (1) a top sheet of polymeric material; (2) a first layer of decorative material; (3) an intermediate sheet of polymeric material; (4) a second layer of a decorative material; and, (5) a bottom sheet of polymeric material.

p. 7, lns. 17-22. Inasmuch as Claims 10-12 are directed to a laminate, drawings in support thereof are not required. MPEP 608.02(III)(D) (“A drawing is not required for a filing date under 35 U.S.C. 111 and 113 if the application contains ... (D) at least one claim directed to a laminated article or product ...”).

With respect to Claims 47-48, 53, 55, 65, 67, 76, 78, 85, and 87, Applicant asserts that the specification adequately discloses a bowl-shaped sink or lavatory formed using the inventive laminate. Sinks and lavatories are known in the art to be bowl-shaped and therefore this attribute was inherently disclosed by the above-mentioned references of sinks and lavatories in the specification.

Claims 1-2, 5-17, and 40-91 stand rejected under 35 U.S.C. §112 ¶2 as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. Examiner asserts that reference to a non-porous unitary solid surface having the decorative object that extends to at least one edge of the matrix is ambiguous because it may refer to an intermediate product or a finished product.

Applicant asserts that the multiple potential meanings of the above term do not render the term unclear. "Breadth of a claim is not to be equated with indefiniteness." MPEP 2173.04. Furthermore, "[i]f the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph." MPEP 2173.04. Accordingly, the fact that the claim term encompasses decorative materials that extend both beyond the edge of a matrix and up to the edge of the matrix does not render the claims unclear. Applicant has made no indication that any other scope is intended.

REJECTION UNDER §102

Claims 1-2, 5-9, 13-17, 19, 49-50, and 72-73 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,837,091 to Theil et al.. Applicant respectfully asserts that

anticipation has not been established. In order to establish anticipation, each and every element of the claimed device must be found in a single prior art reference.

With respect to claims 1, 7, and 13, Applicant asserts that Theil et al. do not disclose encapsulating a decorative object within a matrix such that the decorative object has a thickness of between 25 and 50 percent of the matrix, between 50 and 100 percent of one of the sheets forming the matrix, or a sheet forming the matrix has a thickness between one and two times that of the decorative object. Laminates having the proportion of sheet and decorative object thicknesses claimed are possible through the inventive process disclosed by Applicant and are not taught or suggested by Theil.

Theil et al. expressly teach that their process is only capable of laminating decorative objects having a thickness that is less than 50 percent that of the upper and lower sheets forming the laminate. Col. 5, lns. 21-23. Accordingly, Theil et al. both fail to teach the limitations recited in claims 1, 7, and 13 and teach away from modification of the disclosed laminate to achieve the claimed product.

The method disclosed by Theil et al. is incapable of forming products having the disclosed proportion of sheet and decorative object thickness inasmuch as the rolling process used requires that the sheets remain dimensionally stable during processing. Col. 4, lns. 30-32 (“The surfaces of the adhesions sides (1a) of the sheets or films (1) are heated in such a way that the sheets or films themselves remain dimensionally stable ...”). Encapsulating large objects requires that the melted polymeric material flow around the object in order to avoid voids and air bubbles. In order to embed an object having a thickness greater than 50% of the thickness of one

of the sheets, the sheet would therefore need to be melted beyond the point that it can retain dimensional stability.

The limitations recited in claims 1, 7, and 13 are fully supported by the specification. The specification states that the “[t]he polymeric sheets 16 and 18 may vary in thickness from about 0.004 inch (0.100 mm) to 1.0 inch (25.4 mm).” p. 8, lns. 6-8. The specification further states that some of the decorative materials may have a thickness of up to 1.0 inch. p. 15 lns. 4, 9. These disclosed ranges clearly encompass embodiments in which the decorative object is greater than 50 percent of the thickness of one of the sheets or greater than 25 percent of the thickness of the combined sheets.

With respect to claims 10 and 16, applicant asserts that Theil et al. fail to disclose a matrix comprising a decorative object extending over the entire sheet to each edge of the matrix or covering substantially more than 90 percent of the area of the sheets forming the matrix. Theil et al. in fact teach that “embedded objects are allowed to take up a maximum of 90% of the surface of the adhesion sides.” Col. 5, lns. 23-30.

Claims 2, 5-9, 13-17, 19, 49-50, and 72-73 are dependent on allowable claims 1, 7, 10, 13, and 16 and are therefore allowable for at least the reasons discussed hereinabove.

REJECTION UNDER §103

Claims 10-12 and 60-62 stand rejected under 25 U.S.C. §103(a) as being unpatentable over Theil alone. Claims 1, 2, 5-9, 13-17, 40-61, and 63-91 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,894,048 to Eckart in view of U.S. Patent No. 4,138,300 to Kaetsu et al.. Claims 10-12 and 60-62 stand rejected under 25 U.S.C. :§103(a)


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BLACK LOWE & GRAHAM ^{PC,LLC}


701 Fifth Avenue, Suite 4800
Seattle, Washington 98104
206.381.3300 • F: 206.381.3301

as being unpatentable over Eckart et al. and Kaetsu. Claim 19 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Eckart et al., Kaetsu, and Theil.

With respect to claim 10, Applicant respectfully asserts that Theil et al. do not enable the laminate disclosed. Theil et al. teaches heating the surfaces of two layers then rolling the pressing the heated surfaces together to encapsulate decorative materials. The method disclosed by Theil does not disclose how it may be performed in a multi layer embodiment.

Claims 11, 12, and 60-62 are dependent on allowable claim 10 and are therefor allowable for at least the reasons discussed hereinabove.

With respect to claims 1, 7, and 13, Applicant asserts that neither Theil nor Eckart disclose the proportion of sheet thickness and decorative object thickness recited. Theil limits the thickness of embedded decorative objects to 50 % of the thickness of the layers encapsulating the laminate, as discussed above. Eckart teaches sheets having a thickness of 12.7 mm (Col. 7, ln. 24) encapsulating films having a thickness of 0.025 to 0.0254 mm (Col. 4, ln. 38). The encapsulated film therefore has a thickness of at most 0.2 percent that of the sheets.

With respect again to claim 10, Applicant asserts that Eckart and Kaetsu, whether alone or in combination, fails to disclose a decorative layer that is both porous and extends over the entire area of the sheets forming a laminate. Eckart discloses laminating a decorative film between two sheets such that the two sheets bond to the film. Col. 1, lns. 56-67. As discussed above, Theil et al. fail to teach or suggest extending decorative objects over the entire surface of sheets forming a matrix. Theil et al. teach against combination with Eckart inasmuch as Theil et

al. insist that the decorative object extend over no more than 90 percent of the surface area of the sheets forming the matrix.

Claims 2, 5, 8-9, 14-15, 17, 19, 40-62, and 63-91 are dependent on allowable claims 1, 7, 10, 13, and 16 and are therefore allowable for at least the reasons discussed hereinabove.

CONCLUSION

Applicant submits that the application is in condition for immediate allowance. In the event that this response evokes any question, Applicant respectfully requests that the Examiner direct any questions to Applicant's undersigned attorney.

Respectfully submitted,

BLACK LOWE & GRAHAM^{PLLC}



Lawrence D. Graham
Registration No. 40,001
Direct Dial: 206.381.3300

MAIL CERTIFICATE

I hereby certify that this communication is being deposited with the United States Postal Service via first class mail under 37 C.F.R. § 1.08 on the date indicated below addressed to: MAIL STOP AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

10.31.05
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Tricia Walker